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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,135	07/31/2003	Stephen M. Sloboda		6684

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,135

Applicant(s)

SLOBODA, STEPHEN M.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

◇
DETAILED ACTION

This Office action is responsive to communication received 09/29/2004 –
Amendment.

Claims 1-6 remain pending.

Following is an action on the MERITS:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Holdstein. Berry shows every feature claimed with the exception of an end portion being of substantially constant diameter. Instead, Berry notes protuberances (32) that are indicated as being for decoration purposes only, at least insofar as the embodiment disclosed in Figures 1 and 2. Holdstein shows it to be old in the art to show an end portion that is *substantially* constant in diameter. As the end portions in Berry do not appear to add any structural advantage, it would have been obvious to modify the device in Berry simply by changing the configuration of the end portions to resemble an end as shown by Holdstein, merely for aesthetic reasons.

Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Holdstein and Drake. The patent to Berry, as modified, does not provide any specifics for the diameter, length and weight of the putter head. Drake shows it to be old in the art to dimension a generally cylindrical putter head with a length between 3

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and 4 ½ inches, a weight of about 6 to 12 ounces and a diameter between 1 to 1 ¾ inches. See col. 2, lines 24-46 in Drake. It is noted that the applicant has merely set forth a series of preferred dimensions, without regard for the criticality of these measurements. In other words, the specification lacks any explanation of necessary importance for the claimed size requirements. Thus, the dimensions are not deemed critical. In view of the above reasoning and the general teachings in Drake with respect to cylindrically-styled putters, it would have been obvious to one of ordinary skill in the art to modify the device in the cited art reference to Berry by including an overall length, diameter for the central and end portions and club head weight, based upon what the skilled artisan deems to be necessary and convenient.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 STANDS rejected under 35 U.S.C. 102(b) as being anticipated by Holdstein. Note the enlarged substantially cylindrical portions and the central portion of reduced diameter. Holdstein also includes a shaft mounted within a blind bore (shown in Figure 3), wherein the shaft is arranged at a substantially perpendicular orientation with respect to the longitudinal axis of the head.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Jen. Note Figure 3 in Jen showing a central portion that is substantially constant in diameter. The end portions (highlighted on the attached Figure 3) are slightly larger in diameter than

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the body portion and of substantially constant diameter. Figure 3 in Jen is being compared to Figure 7 shown by the applicant. In essence, the term "substantially" used to describe the diameter may include some degree of variation as opposed to a recitation of a purely constant diameter.

Claim 1 STANDS rejected under 35 U.S.C. 102(b) as being anticipated by Hurley. Note that the putt-cue device may serve as a putter head, wherein the diameter of the end portions is greater than the diameter of the central portion. Hurley further includes a blind bore adjacent the central portion within which a shaft member is inserted.

RESPONSE TO ARGUMENTS

In the arguments received 09/29/2004, the applicant contends that none of the prior art references of record show a central portion and end portions, each being of substantially constant diameters, with the end portions having a slightly larger diameter than the central portion. It is noted that with respect to the Holdstein reference, the applicant argues that the prior art does not show a "constant diameter" for the end portions, rather than discussing a substantially constant diameter.

In response to these arguments, it is noted that the term "substantially" is intended to give some degree of flexibility when interpreting the claim language. The highlighted attachment of Figure 4 of Holdstein, for example, shows that the end portions are "substantially" of constant diameter, given the broadest reasonable interpretation of the claimed language. Likewise, the highlighted attachment of Figure 3 of Jen shows an arrangement wherein the body portion and end portions each include

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“substantially” constant diameters. In a similar fashion, the Hurley device is believed to show “substantially” constant diameters for each of the central portion and the end portions. While the applicant additionally argues that the end portions in the Hurley device show two styles of striking heads, there is nothing in the claims that precludes the end portions from being of different sizes (i.e., different length). All that is required is that the end portions have a slightly larger diameter than the central portion.

With respect to the prior art rejection involving the patent to Mullins, applicant's comments on page 5, lines 7-9 are deemed persuasive. Thus, the rejection of claim 1 based upon Mullins has been overcome.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
December 17, 2004